Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-53 are pending in the application, with 1, 24, and 41 being the independent claims. Claims 38-40 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 1, 4-5, 9, 12-18, 23-24, 34, 37, and 41-45 are amended to clarify the invention. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

On page 2 of the Office Action, claims 1, 13-18, 23-24, 35-38, 41-42, 44, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2003/0048781 to Pierson (herein "Pierson") in view of US Patent No. 6,438,717 to Butler *et al* (herein "Butler"). Applicants traverse this rejection and respectfully request this rejection be removed and this claim be passed to allowance.

Applicants respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose all elements of pending independent claims 1 and 24. Claims 1 and 24 as amended recite in part:

> a packet transmit circuit including *a first memory for storing transmit bit error rate test packet data*, wherein the packet transmit circuit is coupled to a channel under test. (Emphasis added).

Applicants' respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose *a first memory for storing transmit bit error rate test packet data* as recited in claims 1 and 24. (Emphasis added). Specifically, per page 2 of the Office Action, "Pierson does not explicitly teach the specific use of a packet transmit circuit including a first memory for storing transmit packet data." Thus, Pierson does not explicitly teach the specific use of a packet transmit circuit including a first memory for storing transmit bit error rate test packet data.

Butler does not overcome this deficiency of Pierson. Specifically, figure 1 of Butler shows an arrow pointing into the Interface Control Block (3) only *from* the Transmit Buffer (6) and no arrow pointing *into* the Transmit Buffer (6). Also, no arrow is shown to be pointing from the BERTestOut (8) block into the Transmit Buffer (6). Thus, Butler does not disclose *a first memory for storing transmit bit error rate test packet data* as recited in Applicants' claims 1 and 24, since the transmit buffer does not receive any data from the BERTTesTout (8). Further, element 6 indicates that "normal mode data " is transmitted from the transmit buffer 6, not test packet data.

Further, Applicants' claims 1 and 24 recites that the packet transmit circuit generates *an arbitrary packet pattern* for testing purposes. There is no indication in the mentioned portions of Pierson that the test patterns are arbitrary. Further, Butler does not cure this deficiency. Accordingly, this feature is also not taught or suggested by Pierson or Butler, or their combination.

Applicants respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose all elements of pending independent claim 41. Claim 41 as amended recites in part:

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generating a test packet including an arbitrary marker pattern;
loading the test packet into the transmitter memory. (Emphasis added).

Applicants' respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose "*loading the test packet into the transmitter memory*" as recited in claim 41. (Emphasis added). As asserted above, Pierson and Butler do not teach use of a transmit circuit including a memory for storing transmit bit error rate test packet data, thus Pierson and Butler do not disclose loading a test packet into transmitter memory.

Further, claim 41 recites that the test packet includes *an arbitrary marker pattern*. The mentioned portions of Pierson and Butler do not recite such a test packet pattern. Accordingly, this feature is also not taught or suggested by Pierson and Butler or their combination, and therefore the prima facie requirements for obviousness are not satisfied by their combination.

Therefore, because neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose all of the recited claim limitations of independent claims 1, 24, and 41 for at least the reasons herein, a *prima facie* case of obviousness has not been established. Furthermore, dependent claims 13-18, 23, 35-37, 42, 44, and 51, which depend upon their respective independent claims 1, 24, and 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 5 of the Office Action, claims 2-3, 29-30, 39-40, 43, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler,

further in view of US Patent No. 6,140,956 to Hillman *et al* (herein "Hillman").

Applicants traverse this rejection and respectfully request this rejection be removed and

these claims be passed to allowance.

Dependent claims 2-3, 29-30, 43, and 45 depend from their respective

independent claims 1, 24, and 41. Hillman does not cure the deficiencies mentioned

above for Pierson in view of Butler. Accordingly, claims 2-3, 29-30, 43, and 45 are

allowable for at least being dependent from an allowable independent claim, in addition

to their own respective features. Claims 39-40 are sought to be cancelled without

prejudice to or disclaimer of the subject matter therein. Accordingly, Applicants

respectfully request this rejection be removed and that these claims be passed to

allowance.

On page 7 of the Office Action, claims 4-5, 19-22, and 25-28 stand rejected under

35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view

of US Patent Publication No. 2002/0054569 to Morikawa *et al* (herein "Morikawa").

Applicants traverse this rejection and respectfully request this rejection be removed and

these claims be passed to allowance.

Dependent claims 4-5, 19-22, and 25-28, which depend upon their respective

independent claims 1 and 24, are allowable for at least being dependent from an

allowable independent claim, in addition to their own respective features. Morikawa does

not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants

respectfully request this rejection be removed and that these claims be passed to

allowance.

On page 10 of the Office Action, claims 6-7 and 48-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of US Patent No. 5,726,991 to Chen *et al* (herein "Chen"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 6-7 and 48-49, which depend upon their respective independent claims 1 and 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Chen does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 11 of the Office Action, claims 8 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of US Patent Publication No. 2001/0012288 to Yu *et al* (herein "Yu"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 8 and 50, which depend upon their respective independent claims 1 and 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Yu does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 12 of the Office Action, claims 9-12 and 31-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of US Patent Publication No. 2003/0009307 to Mejia *et al* (herein "Mejia"). Applicants

traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 9-12 and 31-34, which depend upon their respective independent claims 1 and 24, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Mejia does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.
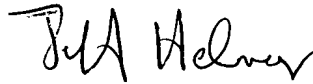
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully

requested.

Respectfully submitted,

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